

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:

see form PCT/ISA/220

## PCT

### WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing

(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference  
see form PCT/ISA/220

#### FOR FURTHER ACTION

See paragraph 2 below

International application No.  
PCT/EP2004/002327

International filing date (day/month/year)  
08.03.2004

Priority date (day/month/year)  
20.03.2003

International Patent Classification (IPC) or both national classification and IPC  
C03B19/12

Applicant  
NOVARA TECHNOLOGY S.R.L.

#### 1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☒ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

#### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1 bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

#### 3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



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**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

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**Box No. I Basis of the opinion**

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1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.  
☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material:  
☐ a sequence listing  
☐ table(s) related to the sequence listing
  - b. format of material:  
☐ in written format  
☐ in computer readable form
  - c. time of filing/furnishing:  
☐ contained in the international application as filed.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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**Box No. II    Priority**

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1. ☒ The following document has not been furnished:

☒ copy of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

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**Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

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The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

- ☐ the entire international application,
- ☒ claims Nos. 1-7 (in part)

because:

- ☐ the said international application, or the said claims Nos. relate to the following subject matter which does not require an international preliminary examination (*specify*):
- ☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (*specify*):
- ☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.
- ☒ no international search report has been established for the whole application or for said claims Nos. 1-7 (in part)
- ☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:
  - the written form ☐ has not been furnished
  - ☐ does not comply with the standard
  - the computer readable form ☐ has not been furnished
  - ☐ does not comply with the standard
- ☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-*bis* of the Administrative Instructions.
- ☐ See separate sheet for further details

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**Box No. V Reasoned statement under Rule 43bis.1(a)(I) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

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**1. Statement**

Novelty (N)	Yes: Claims	3,5,7
	No: Claims	1,2,4,6
Inventive step (IS)	Yes: Claims	.
	No: Claims	1-7
Industrial applicability (IA)	Yes: Claims	1-7
	No: Claims	

**2. Citations and explanations**

**see separate sheet**

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**Box No. VIII Certain observations on the international application**

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The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

**see separate sheet**

Re Item V.

- 1 Present claims 2-7 relate to an extremely large number of possible methods, whereas the application provides support within the meaning of Article 6 PCT and disclosure within the meaning of Article 5 PCT for only a very limited number of such products. In the present case, the claims so lack support, and the application so lacks disclosure, that a meaningful search over the whole of the claimed scope is impossible. Independent of the above reasoning, the claims also contain so many options, variables, possible permutations and provisos that a lack of clarity within the meaning of Article 6 PCT arises to such an extent as to render a meaningful search of the claims impossible.

Present claim 1 relates to a product defined by reference to a desirable characteristic and property, namely almost complete isotropy and dimensions  $\leq 500 \mu\text{m}$ . The claim covers all products having this characteristic and property, whereas the application provides support within the meaning of Article 6 PCT and disclosure within the meaning of Article 5 PCT for only a very limited number of such products. In the present case, the claims so lack support, and the application so lacks disclosure, that a meaningful search over the whole of the claimed scope is impossible.

Thus the search was carried out for those parts of the claims which appear to be clear, supported and disclosed, namely those parts relating to the process of producing a mould having a structured surface, taking a cast of this mould & using the cast as a further mould for sol-gel casting of silica and repeating until the desired dimensions of claim 1 are achieved through shrinkage to produce a silica glass optical product having a micro-structured surface - also the silica glass optical product having a micro-structured surface with a dimension of  $\leq 500 \mu\text{m}$  obtainable by sol-gel processing.

Consequently Item V of the written opinion is restricted to what was searched.

- 2 The following documents are referred to in this communication:

D1 : WO 93/21120 A

D2 : EP 0 705 797 A

- 3 The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of independent claims 1, 2, 4, 6 is not new in the sense of Article 33(2) PCT, for reasons which follow.

Document D1 discloses a sol-gel process of producing silica glass optical elements having micro-structured surfaces of dimension  $< 500 \mu\text{m}$  by repeated

miniaturisation of the sol-gel derived body using an intermediate body as a mould for further processing based on the same insight re shrinkage of the gel and isotropy (see e.g. page 3, § 2 to page 4, § 1; page 6, § 2; claim 1).

- 4 Whilst new (in the sense of Article 33(2) PCT) compared with document D1, dependent claims 3, 5 7 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of inventive step (Article 33(3) PCT).

Re claim 3: the skilled person would find a material for the master mould that would enable the fine structure to be formed in its surface, aluminium is well known to be easily machinable to form such structures and suitable as a mould for sol-gel processing. Re claim 5: it is also normal in the art to prevent sticking, should such occur, by lubricating the mould. Re claim 7: the addition of dopants such as those defined in claim 7 are common in the art, see also document D2.

- 5 Claims 1-7 meet the criteria of Article 33(4) PCT as they can be used to produce glass elements, the latter for optical applications.

**Re Item VIII.**

- 1 Most of the embodiments indicated in table 1 on page 11 of the present international application do not fall within the definition of either independent claim 1 for a product or claim 2 for a process. Neither claim 1 nor claim 2 meets the criteria of Article 6 PCT in respect of support and clarity, nor does the application meet the criteria of Article 5 PCT in respect of disclosure.